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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COURSON, TANIA C

ART UNIT PAPER NUMBER

2859

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,051

Applicant(s)

JIMENEZ ET AL.

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-3, 6, 10, 12-15, 17, 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Coplan (US2002/0095804 A1).

Coplan discloses in Figures 1-2, a measuring and cutting device with safety guard comprising:

- a) an elongated finger-resting surface/first portion (Fig. 1, top surface 9);
- b) said elongated finger-resting surface/first portion having a bottom surface opposite said finger-resting surface (Fig. 1, bottom surface 5);
- c) an elongated upstanding section/second portion projecting upwardly from said finger-resting surface (Fig. 1, guard wall 33) and having an uppermost free end (Fig. 1);

- d) an elongated scale-supporting section coupled to and extending along said upstanding section (Fig. 1, means for mounting measuring tape 47) with said upstanding section being positioned between said scale-supporting section and said finger-resting surface (Fig. 2), said scale-supporting section being inclined with respect to a guiding device supporting surface (Fig. 2);
- e) an elongated first scale having a lower surface and an upper surface (Fig. 1, metal measuring tape 49), said lower surface being rigidly and unreleasably attached to said scale-supporting section (column 3, paragraph 28) and said upper surface having first indicia to indicate predetermined lengths along said first scale (Fig. 1);
- f) said elongated first scale made of metal (Fig. 1, metal measuring tape 49);
- g) wherein said finger-resting surface is substantially flat (Fig. 2);
- h) wherein said finger-resting surface, said upstanding section, and said scale supporting section are integrally formed as a unitary, one-piece element (Fig. 2);
- i) a substantially flat contact surface (Fig. 1) positioned beneath said finger-resting surface, said upstanding section, and said scale supporting section to permit smooth application of said guiding device on the working surface (Fig. 1);
- j) wherein said upstanding section is a wall having a first side facing said first scale and a second side (Fig. 2) facing said finger-resting surface, with said first side being inclined with respect to said scale-supporting section (Fig. 2);
- k) wherein said guiding device/first and second portions have a generally T-shaped cross-section (Fig. 2), and;

- l) wherein said upstanding section has a closed free end that contains no upwardly projecting openings (Fig. 2).

With respect to the intended use of the apparatus, e.g. permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement and being configured to be placed against a substantially flat working surface: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

3. Claims 1, 6-9, 13 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Russo (US 1,091,461).

Russo discloses in Figures 4-5, a measuring attachment comprising:

- a) an elongated finger-resting surface/first portion (Fig. 4, recess 14);
- b) said elongated finger-resting surface/first portion having a bottom surface opposite said finger-resting surface (Fig. 4, face 12);
- c) an elongated upstanding section/second portion projecting upwardly from said finger-resting surface (Fig. 1, straightedge 13) and having an uppermost free end (Fig. 4);
- d) an elongated scale-supporting section coupled to and extending along said upstanding section (Fig. 4) with said upstanding section being positioned between said scale-supporting section and said finger-resting surface (Fig. 4), said

scale-supporting section being inclined with respect to a guiding device supporting surface (Fig. 5);

- e) an elongated first scale having a lower surface and an upper surface (Fig. 4, extension 22), said lower surface being rigidly and unreleasably attached to said scale-supporting section (Fig. 4) and said upper surface having first indicia to indicate predetermined lengths along said first scale (Fig. 4);
- f) said elongated first scale made of metal (column 2, lines 9-10);
- g) wherein said guiding device/first and second portions have a generally T-shaped cross-section (Fig. 5);
- h) a substantially flat contact surface (Fig. 5) positioned beneath said finger-resting surface, said upstanding section, and said scale supporting section to permit smooth application of said guiding device on the working surface (Fig. 4);
- i) wherein said contact/bottom surface includes second indicia indicating predetermined lengths along said contact/bottom surface (Fig. 5);
- j) wherein said second indicia is printing on said contact surface (Fig. 5), and;
- k) wherein said contact surface includes an elongated recess (Fig. 5).

With respect to the intended use of the apparatus, e.g. permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement and being configured to be placed against a substantially flat working surface: It has been held that a recitation with respect to the manner in which a claimed apparatus

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is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coplan, as applied to claims 1-3, 6, 10, 12-15, 17, 19-23 as stated above, in view of Keller (DE4317819 A1).

Coplan discloses a measuring and cutting device with safety guard as stated above in paragraph 2.

Coplan does not disclose a finger-resting surface, an upstanding section and a scale supporting section formed of plastic and said first scale having a non-metallic coating on an upper surface.

Regarding claims 4 and 16: Coplan disclose the finger-resting surface, the upstanding section, and the scale supporting section of an aluminum (paragraph 26, last 5 lines) material. The particular type of material used to make the finger-resting surface, the upstanding section,

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and the scale supporting section, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

Keller teaches a measuring device that consists of a first scale having a non-metallic coating on an upper surface (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the a measuring and cutting device with safety guard of Coplan, so as to include a first scale having a non-metallic coating on an upper surface, as taught by Keller, so as to provide a means for increasing protection by providing an anti-corrosion layer.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coplan, as applied to claims 1-3, 6, 10, 12-15, 17, 19-23 as stated above, in view of Schwartz et al. (US 4,601,598).

Coplan discloses a measuring and cutting device with safety guard as stated above in paragraph 2.

Coplan does not disclose a second side including a plurality of ribs.

Schwartz et al. teaches a finger-gripping component for a device that consists of a second side including a plurality of ribs (Fig. 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the a measuring and cutting device with safety guard of Coplan, so as to include a second side including a plurality of ribs, as taught by Schwartz et al., so as to provide a means for increasing grip control of the device.

Response to Arguments

7. Applicant's arguments filed on January 14, 2003, have been considered but are moot in view of the new ground(s) of rejection.

8. The Final Rejection stated in the last Office Action has been reconsidered and is now withdrawn.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose a measuring devices with guards:

Little (US 2,247,157)

Speedpress Catalogue, Aluminum Safety Ruler, April 14, 2000

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
January 28, 2003